

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Eric V. Kline

Group Art Unit: 2841

Conf. No.: 1799

Examiner: Ishwarbhai Patel

Appln. No.: 09/759,018

Attorney Docket No.: FIS920000310US1

Filing Date: January 12, 2001

Date: February 20, 2008

Title: COMPOSITION AND METHOD FOR CONTAINING METAL IONS IN ELECTRONIC
DEVICES

REPLY BRIEF

Hon. Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Appellant is submitting herewith a Reply Brief, as permitted by 37 CFR §41.41, in response to the Examiner's Answer mailed January 23, 2008, in the instant application.

REMARKS

Appellant is submitting arguments and remarks herewith in response to the Examiner's Answer mailed January 23, 2008.

It is noted that Section (9) Grounds of Rejection of the Examiner's Answer is a word for word recitation of the second Final Rejection referenced in Appellant's Supplemental Appeal Brief. Accordingly, arguments and remarks made by Appellant in its Supplemental Appeal Brief are equally applicable to the Grounds of Rejection restated in the Examiner's Answer.

In regards to Section (10) Response to Argument of the Examiner's Answer, the Examiner made some new arguments and remarks to which Appellant will respond below.

Section (10) Response to Argument, subsection (i):

In Section (10) Response to Argument, subsection (i), the Examiner states in part that "The prior art of Burger [sic] (column 4, line 34-35) discloses a silicone containing polyimide composition. Polyimide are high molecular particles and the combination of these two element exist as a stable material as is used as coating material by Berger (element 34, figure 1). This shows that the polyimide particles are immobile and insoluble in the in [sic] the [sic] combination (composition) of silicone. Therefore, Berger meets the limitation."

Appellant's Response to subsection (i):

The Examiner's remarks demonstrate his misunderstanding of the reference and of Appellant's invention. As to the reference, the material cited at column 4, lines 34-35, is a silicone-containing polyimide copolymer. This means there is silicone in a polyimide material, both of which together form a copolymer. As shown at col. 5, lines 25-30 of Berger, the silicone is incorporated into the polyimide backbone to form a silicone containing polyimide copolymer. There is no disclosure in Berger of "polyimide particles" immobile and insoluble in the silicone as erroneously suggested by the Examiner.

Further, claim 4, which the reference must anticipate by meeting every limitation of the claim, recites (i) a matrix material, (ii) a polymer which serves as an insoluble and immobile particle phase in said matrix material and (iii) a chelating agent which is bonded to said insoluble and immobile particle phase. The Examiner has shown a matrix material – the silicone containing polyimide copolymer. The Examiner has not shown a polymer which serves as an insoluble and immobile particle phase and a chelating agent which is bonded to said insoluble and immobile particle phase.

Section (10) Response to Argument, subsection (ii):

The Examiner states in part in subsection (ii) that “The prior art Burger [sic] discloses a silicone containing polyimide composition (column 4, line 34-35) including diamines (column 5, line 1 to column 8, line 33), diamines is considered as a chelating agent). All these elements forms [sic] coating material (element 34, figure 1). This shows that the elements are bonded permanently together. Therefore, Berger meets the limitation.”

Appellant’s response to subsection (ii):

Appellant’s arguments above in response to subsection (i) are equally applicable. The Examiner’s rejection is facially defective since the references do not teach (i) a matrix material, (ii) a polymer which serves as an insoluble and immobile particle phase in said matrix material and (iii) a chelating agent which is bonded to said insoluble and immobile particle phase as is required by claim 4. The diamines referenced by the Examiner are used as a reactant in the formation of the silicone containing polyimide copolymer. See col. 5, lines 60-65 and col. 6, lines 54-68 of Berger.

Further, the Examiner’s statement that “the elements are bonded permanently together” is incomplete and misses the point. The Examiner must show that the references teach the chelating agent is bonded (permanently as taught by Appellant’s specification) to the polymer which serves as an insoluble and immobile particle phase. This the Examiner has not done. That all “the elements are bonded permanently together” (assuming *arguendo* that the reference teaches the matrix, polymer and chelating agent as recited by Appellant) as arguably taught by the reference

misses the point since this is **not** what is claimed by Appellant – Appellant claims that the chelating agent in Appellant’s invention is bonded to the insoluble and immobile polymer; there is no teaching in the references that the chelating agent per se is bonded to the insoluble and immobile polymer.

Section (10) Response to Argument, subsection (iii):

The Examiner’s argument appears to be a bit unclear but, to the extent the argument is understood, the Examiner is saying that the board of Raiser could be modified with the composition of Berger so as to have the Berger composition on the board of Raiser. The Examiner goes on to state that “It is to be noted that the limitation ‘wherein said composition is said organic package’, as is unclear, is considered as ‘the said composition is part of the organic package’.”

Appellant’s response to subsection (iii):

Appellant attempted to clear up the Examiner’s apparent confusion regarding the language of claim 9 in the interview with the Examiner on April 7, 2006 and believed that it was resolved. Appellant explained that the meaning of the claim language is the organic package is made from “said composition”, i.e., “wherein said composition is said organic package”. The Appellant is **not** claiming that “said composition is part of the organic package”. The Examiner has clearly and erroneously added limitations to claim 9 that are not part of claim 9. Appellant’s other claims, such as claims 5 and 13, wherein a coating is claimed are more in line with the Examiner’s erroneous interpretation of claim 9.

Given the Examiner’s erroneous interpretation of claim 9, it is clear that Raiser and Berger do not teach an organic package “wherein said composition is said organic package”.

Section (10) Response to Argument, subsection (iv):

The Examiner’s arguments with respect to claim 12 are essentially the same as the Examiner’s arguments with respect to claim 9. Again, the Examiner states that “It is to be noted

that the limitation ‘wherein said composition is said printed circuit board’, as is unclear, is considered as ‘the said composition is part of the printed circuit board’.”

Appellant’s response to subsection (iv):

Appellant’s arguments and remarks are the same as was made above with respect to claim 9.

Summary:

In view of all of the preceding remarks, it is submitted that claims 4 to 13 are in condition for allowance, the Examiner's various objections and rejections of claims 4 to 13 are erroneous and reversal of the Examiner's decisions is respectfully requested.

Respectfully Submitted,
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